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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/388,191	09/01/1999	MARK G. DREYER	27600/M195A	3487
29471	7590	12/12/2006	EXAMINER	
MCCRACKEN & FRANK LLP 200 W. ADAMS STREET SUITE 2150 CHICAGO, IL 60606			PAULA, CESAR B	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/388,191

Applicant(s)

DREYER ET AL.

Examiner

CESAR B. PAULA

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply -

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the appeal brief filed on 9/21/2006.

This action is made Non-Final.

2. In the brief, claims 1-26 are pending in the case. Claims 1, and 16 are independent claims.

Drawings

3. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 5-9, and 11-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Nehab et al, hereinafter Nehab (USPat.# 6,029,182, 2/2000, filed on 10/1996).

Regarding independent claim 1, Nehab discloses a user creating or editing a personal news profile template for generating a personalized newspaper-- a first routine that provides for generation of a template (col.9, lines 35-67).

Additionally, Nehab discloses retrieving information from an html web page, and storing it in a flattened document. The data in the flattened document— *a second routine that provides for extraction of data from the first page description file to database for storing the data indicative of the portions of the first page description file--* is used for creating a personalized formatted newspaper according to the template's layout commands-- *a third routine that generates the second page description file from the template and the database; wherein the first page description file includes at least layout information for at least one page.* (col.3, lines 15-67, col.12, lines 1-16, 40-64, col. 7, lines 23-67).

Regarding claim 2, which depends on claim 1, Nehab discloses a user creating or editing a personal news profile template for generating a personalized newspaper (col.9, lines 35-67).

Regarding claim 3, which depends on claim 2, Nehab discloses a user uses a gui for creating or editing a personal news profile template for generating a personalized newspaper (col.9, lines 35-col.10, line 67).

Regarding claim 5, which depends on claim 1, Nehab discloses a user uses a gui for creating or editing a personal news profile template, which specifies the layout, and allows for the generation a personalized newspaper (col.9, lines 35-col.10, line 67).

Regarding claim 6, which depends on claim 1, Nehab discloses retrieving news articles from an html web page, and storing it in a flattened document. The articles in the flattened document—*database for storing the data indicative of the portions of the first page description file--* are used for creating a personalized formatted newspaper according to the template's layout commands for each article (col.3, lines 15-67, col.12, lines 1-16, 40-64, col. 7, lines 23-67).

Regarding claim 7, which depends on claim 1, Nehab discloses retrieving news articles from an html web page, and storing it in a flattened document. (col.3, lines 15-67, col.12, lines 1-16, 40-64, col. 7, lines 23-67). In other words, the web page is parsed, and the articles are extracted from the markup language.

Regarding claim 8, which depends on claim 7, Nehab discloses retrieving news articles from an html web page, and storing it in a flattened document. (col.3, lines 15-67, col.12, lines 1-16, 40-64, col. 7, lines 23-67). In other words, the web page is parsed, and the articles are extracted from the markup language—*content and control data*.

Regarding claim 9, which depends on claim 8, Nehab discloses retrieving news articles from an html web page, and storing them in a flattened document, and then formatting them according to the template created with the gui (col.3, lines 15-67, col.12, lines 1-16, 40-64, col. 7, lines 23-67). In other words, the web page is parsed, and the articles are extracted from the markup language.

Regarding claim 11, which depends on claim 1, Nehab discloses retrieving news articles from an html web page, and storing it in a flattened document, and then formatting them according to one of the templates created with the gui (col.3, lines 15-67, col.12, lines 1-16, 40-64, col. 7, lines 23-col.8, line 45).

Regarding claim 12, which depends on claim 1, Nehab discloses retrieving news articles from an html web page, and storing them in a flattened document, and then formatting them according to the template created with the gui. The data retrieved can consist of various supported images (col.3, lines 15-67, col.12, lines 1-16, 40-64, col. 7, lines 23-67, col. 24, lines 53-59).

Regarding claim 13, which depends on claim 12, Nehab discloses retrieving news articles from an html web page, and storing it in a flattened document, and then formatting them according to the template created with the gui. The data retrieved can consist of various supported images (col.3, lines 15-67, col.12, lines 1-16, 40-64, col. 7, lines 23-67, col. 24, lines 53-59).

Regarding claim 14, which depends on claim 1, Nehab discloses retrieving news articles from an html web page, and storing them in a flattened document according to the template created with the gui (col.3, lines 15-67, col.12, lines 1-16, 40-64, col. 7, lines 23-67, col. 24, lines 53-59).

Regarding claim 15, which depends on claim 14, Nehab discloses retrieving news articles from an html web page, and storing them in a flattened document , and then formatting them to one's liking using gui (col.3, lines 15-67, col.4, lines 39-67, col.12, lines 1-16, 40-64, col. 7, lines 23-67, col. 24, lines 53-59).

Claims 16-21, 24-26 are directed towards a method for implementing the system found in claims 1, 3, 5-8, 11-12, and 14 respectively, and therefore are similarly rejected.

Claim 22 is directed towards a method for implementing the system found in claim 1, and therefore is similarly rejected.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson, A., hereinafter Simpson, Sybex, 1993, pp.539-579, 852-859, in view of Hohensee et al, hereinafter Hohensee, (USPat.# 6,407,821 B1, 6/18/2002, filed on 9/8/1998).

Art Unit: 2178

Regarding claim 4, which depends on claim 1, Nehab discloses retrieving information from an html web page, and storing it in a flattened document. The data in the flattened document is used for creating a personalized formatted newspaper according to the template's layout commands (col.3, lines 15-67, col.12, lines 1-16, 40-64, col. 7, lines 23-67). Nehab fails to explicitly disclose: *page make-up software application comprises QuarkXPress*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have included QuarkXPress, because of all the reasons found in Nehab, including allowing a user to retrieve hypermedia documents and then format, so that a user could scan and read them in a natural fashion (col.2, lines 40-67). Thus, providing the benefit of creating a personalized document that allows a user to look at the sections he finds interesting, and grab his attention using an application such as *QuarkXPress*.

8. Claims 10, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nehab, in view of Mastie (Pat. # 6,480,866, 11/12/02, filed on 6/30/98).

Regarding claim 10, which depends on claim 1, Nehab discloses a user creating or editing a personal news profile template for generating a personalized newspaper (col.9, lines 35-67). Nehab fails to explicitly disclose: *plurality of pages to be printed in a book*. However, Mastie teaches the printing of a plurality of pages in a book (c.4,L.14-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of

Art Unit: 2178

Nehab, and Mastie, because of all the reasons found in Mastie above including the creation of a book onto a single document which can be printed, stored, retrieved, etc.

Claim 23 is directed towards a method for implementing the system found in claim 10, and therefore is similarly rejected.

Response to Arguments

9. Applicant's arguments filed 9/21/2006 have been fully considered but they are moot in light of the new grounds of rejection above.

Conclusion

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://portal.uspto.gov/external/portal/pair>. Should you have any questions about


Art Unit: 2178

access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866
217-9197 (toll-free).

Any response to this Action should be mailed to:
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

- (571)-273-8300 (for all Formal communications intended for entry)


CESAR PAULA
PRIMARY EXAMINER
12/11/06